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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,791	03/21/2006	Atsushi Mae	SON-3402	3409
23353 7590 05/01/2009 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER CHEVALIER, ROBERT				
ART UNIT		PAPER NUMBER		
2621				
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05/01/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/572,791

**Applicant(s)**

MAE ET AL.

**Examiner**

ROBERT CHEVALIER

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the submitted prior art of Willis et al (WO 01/35650 A1).

Willis et al discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 1, 5-7, including the feature of dividing video data stream into data segments (See Willis et al's Figure 3), the feature of generating additional information regarding the relationship between the video data contained in the data segment and the video data contained in another data segment or additional information regarding characteristics of the video data contained in each data segment (See the Navigation pack shown in Willis et al's Figure 3, and furthermore, see Willis et al's page 2, lines 22-29), the feature of multiplexing the additional data with the data segment and recording the same onto the data recording medium as specified in the present claims 1, 5-7. (See Willis et al's Figure 3, and Figure 1, components 154, 106).

With regard to claims 2, 9, the feature of the additional information comprising at least one piece of decode information indicating whether to use video data contained in another data segment when the video data contained in one data segment is decoded, reproduction order information relating to a reproduction order of the video data that is

contained in the data segment and is to be accessed when the video stream is randomly accessed, video data amount information regarding the amount of video data contained in the video segment, and scanning method information regarding a scanning method of the video data contained in the data segment as specified thereof is present in Willis et al. (See Willis et al's page 2, line 22, to page 3, line 16).

With regard to claims 3, 10, the feature of the video stream being encoded in compliance with MPEG and the data segment is a VOB as specified thereof is present in Willis et al. (See Willis et al's Figure 3).

With regard to claims 4, 14, the feature of the additional information comprising at least one piece of information equivalent to a broken link flag, information regarding a reproduction order of I-pictures in the VOB, the number of frames of video to be reproduced by the VOB, the number of pages of video data contained in the VOB, and information equivalent to a progressive frame flag as specified thereof is present in Willis et al. (See Willis et al's Figures 7-9).

With regard to claims 8, 11, 17-19, the feature of controlling reproducing of the video data based on additional information contained in the read additional data as specified thereof is present in Willis et al. (See Willis et al's Figure 1, components 122, 178, 174, 172, 176).

With regard to claim 12, the feature of the video stream being a video stream that has been encoded in compliance with MPEG2, the data segment being a VOB, and the reproduction order information being information regarding the reproduction order of

I-Pictures in the VOB as specified thereof is present in Willis et al. (See Willis et al's Figure 3, and further, see Willis et al's Figures 7-9).

With regard to claim 13, the feature of the additional information comprising video data amount information regarding the amount of video data contained in the data segment, and the feature of managing the number of frames of video reproduced from the video stream, or the number of pages of video data contained in the video stream based on the video data amount information as specified thereof is present in Willis et al. (Willis et al's claim 24).

With regard to claims 15-16, the feature of correcting output signal responsive to the video data as specified thereof is present in Willis et al. (See Willis et al's Figure 1, component 130).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7, and 19, are rejected under 35 U.S.C. 101 because the claim is directed to a program having nonfunctional descriptive material.

Programs not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lane et al discloses a video recording/reproducing apparatus including recording additional data with the video data segments on the recording medium.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT CHEVALIER whose telephone number is (571)272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/ROBERT CHEVALIER/  
Primary Examiner, Art Unit 2621  
April 29, 2009.